U.S. Serial No. 09/490,495
Response to the Office Action Dated July 16, 2003

REMARKS

The applicant has carefully considered the Office action dated

July 16, 2003 and the references it cites. By way of this Response, claims

242-244, 249, 253-255, 259, 263, 267-268, 271, 275-276, 278-280, 287, 290,

and 291 have been amended to clarify the issues for appeal, and claims 292-

312 have been cancelled without prejudice to their further prosecution. In

view of the following, it is respectfully submitted that all pending claims are in

condition for allowance and favorable reconsideration is respectfully

requested.

As an initial matter, the applicant respectfully submits that the Office

action was improperly made final. The Office action's statement that all

claims are drawn to the same invention claimed in the earlier application and

could have been finally rejected on the grounds and art of record in the next

Office action if they had been entered in the earlier application" (Office

action, paragraph 34), is also traversed as plainly in error. As can be seen by

even a cursory comparison of the previously cancelled claims and the claims

now pending in the application, the claims presented in this case are entirely

new and distinct from the claims previously presented in the parent

application. Therefore, the Office action was improperly made final.

However, since the rejections made in the Office action are based on factual

and legal errors demonstrating a failure to apprehend the subject matter at

issue in this case, the applicant is pursuing entry of this amendment and

reversal through appeal rather than further delaying these proceedings with

seeking reversal of the erroneous holding of "finality."

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Applicant respectfully traverses the § 112, second paragraph, rejections. Turning to the rejection of claim 248, as its basis for rejection, the Office erroneously states the "claimed function of 'performing analysis' is too broad because analysis can have many different meaning." However, breadth is an entirely invalid basis for rejecting a claim under 35 U.S.C. § 112, second paragraph. Indeed, section 2173.04 of the MPEP is entitled "Breadth Is Not Indefiniteness." Therefore, the Office action's rejection of claim 248 because it is "too broad" is improper as a matter of law.

The second rationale for rejecting claim 248 under 35 U.S.C. § 112, second paragraph, is also in error. In particular, the Office action contends that claim 248 is indefinite because "there is inherency in claim for 'analyzing/using' data (in other word, this task MUST be done and no need to claim this feature.)" (Office action, paragraph 4(A)). However, this is not true. Claim 247, from which claim 248 depends, merely requires that the monitoring information be stored at the remote site. Of course, storing information is not analyzing information. Therefore, there is no inherent analysis performed by the remote site in the claims from which claim 248 depends. Instead, the analysis function is only introduced in claim 248. As a result, the Office action's position that "this task MUST be done and there is no need to claim this feature" is factually incorrect.

From the foregoing, it is clear that the 35 U.S.C. § 112, second paragraph, rejection of claim 248 is based on errors of law and fact. Therefore, the 35 U.S.C. § 112, second paragraph, rejection of claim 248 should be withdrawn to narrow the issues for appeal.

The 35 U.S.C. § 112, second paragraph, rejections of claims 242-279 recited in paragraph 4(B) are incomprehensible and must be withdrawn. In particular, those rejections contend that "claims 242-279 called for an article of manufacture (i.e., a computer readable medium); however, above claims are directed to methods combining with an article of manufacture." (Office action, paragraph 4(B)). However, a brief review of the pending claims reveals that claims 242-274 are system claims, not method claims. Therefore, the 35 U.S.C. § 112, second paragraph, rejection of those claims is plainly based on factual error. Similarly, claims 275-279 are unambiguous method claims. Accordingly, the Office action has failed to identify anything indefinite about claims 242-279 that would support the 35 U.S.C. § 112, second paragraph, rejections. As a result, the 35 U.S.C. § 112, second paragraph, rejections of claims 242-279 should be withdrawn to narrow the issues for appeal.

Turning to the art rejections, the applicant respectfully traverses each of the rejections. At the outset, applicant notes that various amendments have been made throughout the claims. As demonstrated by the fact that all of the rejections of the pending claims are based on factual errors and an apparent misunderstanding of the claim language before the Office, none of these amendments were required to overcome the rejections made in the final Office action. Instead, all of the amendments are clarifying amendments that are being made to more clearly recite inherencies in the unamended claim language and to bring the issues to be appealed into sharper focus. Accordingly, the Office is respectfully requested to enter these clarifying amendments to streamline the appeal process.

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Turning to the rejection of claim 242, the rejections based on Curran et

al., U.K. Patent GB 2,250,112A, can only be based on a failure to understand

both the language of claim 242 and/or the Curran et al. reference itself. For

example, claim 242 recites a content provider site which stores a content file

having embedded therein at least one instruction to cause generation of

monitoring information about the display of content associated with the

content file, and a content display site to receive the content file from the

content provider site and to display the content associated with the content

file. As specified in claim 242, the content display site executes the embedded

instruction when the content file is accessed to cause monitoring information

about the display of the content to be generated.

Curran et al. does not teach or suggest such a system. Instead, Curran

et al. describes a testing system which captures pixel control signals

transmitted to a target screen to monitor what is displayed on that screen.

(Curran et al., abstract, lines 1-4). Thus, while Curran et al. certainly relates to

monitoring display of content on a screen, it has not even the slightest hint of

the specific system recited in claim 242. This can be seen by reviewing the

passages relied upon by the Office action to find the recitations of claim 242.

For instance, the Office action incorrectly alleges that Fig. 1 and the following

passage of Curran et al. disclose a content provider site that stores <u>a content</u>

<u>file having an embedded instruction to cause generation of monitoring</u>

<u>information:</u>

> The device 1 includes a serial capture circuit 3
> and a host computer bus interface 4. The bus
> interface 4 is connected to a host computer 5 by

a cable interface 6.

(Curran et al., Page 3, lines 11-14). However, even a cursory review of this passage and Fig. 1 reveals that it has nothing to do with a content file storing an embedded instruction to cause generation of monitoring information. Thus, the allegation that Curran et al. meets this recitation of claim 242 is clearly without basis in fact.

The Office action goes on to allege that the recitation of "a content display site to receive the content file from the content provider site and to display the content associated with the content file, wherein the content display site executes the ... embedded instruction when the content file is accessed" is met by Fig. 1 and lines 10-21 of page 3 of Curran et al. That passage is reproduced below for ease of reference:

> Referring to the drawings, and initially to Fig. 1, there is illustrated a capture device of the invention, indicated generally by the reference numeral 1. The device 1 includes a serial capture circuit 3 and a host computer bus interface 4. The bus interface 4 is connected to a host computer 5 by a cable interface 6. A screen capture circuit 2 is connected in a target computer 7 and to an interface circuit 8. The serial capture circuit 3 includes a microprocessor and a memory storing simulation programs. It is connected to transmit and receive lines 9 and 10 respectively connecting the target computer 7 with a serial device 11. The serial device may be a computer, a terminal, a tablet, a mouse or any other serial device.

(Curran et al., Page 3, lines 9-21). Again, a review of this passage fails to uncover any hint of a content file with an embedded instruction to cause generation of monitoring information, and, thus, fails to teach or suggest a content display site that receives a content file from a content provider site and

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executes an embedded instruction to cause generation of monitoring

information when the content file is accessed. Accordingly, it is very clear

that there is no teaching or suggestion in Curran et al. of the system recited in

claim 242. As a result, the rejections based on Curran et al. are fatally flawed

and must be withdrawn or reversed on appeal.

Apparently recognizing the weakness of the Curran et al. rejections,

the Office action goes on to patch allegations concerning the operation of the

USPTO's printer station and content provider sites in general into the Curran

et al. rejection. Applicant respectfully traverses these statements as inaccurate

and improper. Rejections must be based on actual evidence. In re Warner,

379 F.2d 1011, 1017 (C.C.P.A. 1967). It is impractical, unreasonable and

unfair for an applicant to be expected to respond to conjecture about how

undocumented systems at the USPTO or elsewhere might possibly work.

Indeed, the MPEP expressly states:

> When a rejection is based on facts within
> the personal knowledge of the examiner, the
> data should be stated as specifically as possible,
> and the facts must be supported, when called for
> by the applicant, by an affidavit from the
> examiner.

MPEP § 2144.03 (emphasis added). As the references to the USPTO printer

system and content provider sites in general appear to be based on nothing

more than alleged personal knowledge of the examiner, applicant hereby

respectfully requests the examiner to withdraw the statements or to provide the

applicant with a suitable affidavit explaining in detail the basis for his opinion

as required by MPEP § 2144.03. Additionally, the Office should clarify its

position as to whether the rejections are based on Curran et al. or on some combination of Curran et al. and some other reference.

Before the examiner undertakes this process, however, the applicant points out that reviewing the status of a device remotely (i.e., checking a printer queue) is not transferring a content file having embedded therein an instruction to cause generation of monitoring information about the display of the content associated with the content file as recited in claim 242. It is merely transferring monitoring data from one device to another. Therefore, the references to the USPTO printer site are completely irrelevant to claim 242.

As for the Office action's comments concerning cookies, it is noted that a cookie "is information that a Web site puts on your hard disk so that it can remember something about you at a later time. (More technically, it is information for future use that is stored by the server on the client side of a client/server communication.)" (See, for example, the web page at http://searchsecurity.techtarget.com/sDefinition/0,,sid14_gci211838,00.html). Cookies may be a content file, but they do not contain instructions to cause generation of monitoring information about the display of content associated with a content file. Indeed, while cookies are stored at a client site (which may be a content display site), they are not typically accessed by the client device. Instead, the cookies are deposited on a client device to enable a website to identify the client in a later transaction. When the client device contacts a content provider site (e.g., to re-visit a web page), the cookie is automatically transferred back to the content provider site and accessed by the content provider site. Again, it is not accessed by the client (e.g., the content

display site) since it is intended to be used by the content provider site. There
is no hint anywhere in the art of record of modifying cookies to store
embedded instructions to be executed by a content display site to monitor
display of content at the content display site. Therefore, the Office action's
discussion of the existence of "cookies" is irrelevant to the recitations of claim
242.

In view of the foregoing, it is clear the rejections of claim 242 are not
supported in law or in fact. As a result, the rejections of claim 242 and all
claims depending therefrom must be withdrawn.

Independent claim 253 is also allowable. Claim 253 recites a system
comprising a content provider site that stores a content file that has embedded
therein an instruction to cause detection of display of content associated with
the content file. As explained in detail above, none of the art of record teaches
or suggests such a content file, and, thus, none of the art of record teaches or
suggests such a content provider site. On this basis alone, the rejections of
claim 253 are clearly based on reversible error and must be withdrawn.

Claim 253 also recited a content display site to receive the content file
from the content provider site and to display the content associated with the
content file, wherein when the content display site reads the content file, the
embedded instruction is executed thereby causing display of the content to be
detected. As explained in detail above, none of the art of record teaches or
suggests a content display site that executes an instruction embedded in a
content file received from a content provider site to monitor display of the
content associated with the content file. Therefore, the rejections of claim 253
are in error and must be withdrawn.

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In view of the foregoing, claim 253 and all claims depending therefrom must be allowed.

Independent claim 263 is also allowable. Claim 263 recites a computer readable medium having a content file stored thereon, wherein the content file has embedded therein an instruction to cause detection of display of content associated with the content file. As explained in detail above, none of the art of record teaches or suggests such a content file. In addition, claim 263 recites a content display site to display the content associated with the content file, wherein the content display site executes the ... embedded instruction when the content file is accessed. As explained in detail above, none of the art of record teaches or suggests a content display site that executes an instruction embedded in a content file to monitor display of the content associated with the content file. Therefore, the rejections of claim 263 are in error and must be withdrawn. Accordingly, claim 263 and all claims depending therefrom must be allowed.

Independent claim 275 is also allowable. Claim 275 recites a method for detecting when content is displayed at a content display site comprising: receiving at a content display site a content file that has embedded therein an instruction that causes display of content associated with the content file to be detected; and accessing the content file at the content display site to cause display of the content and execution of the embedded instruction. As explained in detail above, none of the art of record teaches or suggests such a content file. Therefore, the rejections of claim 275 are in error and must be withdrawn. Accordingly, claim 275 and all claims depending therefrom must be allowed.

Independent claim 287 is also allowable. Claim 287 recites a computer readable medium containing content for display comprising a content file having embedded therein at least one instruction that, when executed, causes display of content associated with the content file to be detected. As explained in detail above, none of the art of record teaches or suggests such a content file. Therefore, the rejections of claim 287 are in error and must be withdrawn. Accordingly, claim 287 and all claims depending therefrom must be allowed.

Before closing, the applicant notes that none of the amendments made in this response are narrowing. Rather, all of the amendments are either broadening or are merely clarifying in that the amended claim is intended to state the same thing as the claim prior to amendment (i.e., to have the same scope both before and after the amendments) in a more easily understood or more conventional fashion. Consequently, these broadening or clarifying amendments do not give rise to prosecution history estoppel or limit the scope of equivalents of the claims under the doctrine of equivalents.
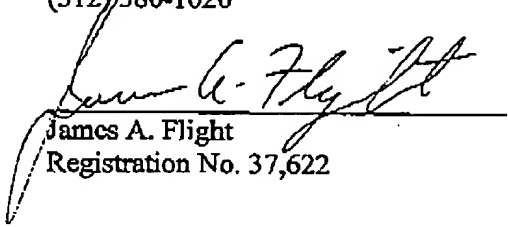
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       If the Examiner is of the opinion that a telephone conference would

expedite the prosecution of this case, the Examiner is invited to contact the

undersigned at the number identified below.

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Respectfully submitted,

GROSSMAN & FLIGHT, LLC.
Suite 4220
20 North Wacker Drive
Chicago, Illinois 60606
(312) 580-1020

</div>

By: _James A. Flight_
       James A. Flight
       Registration No. 37,622

November 17, 2003